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TRANSMITTAL OF APPEAL BRIEF

Docket No.
41241-00006USD1

In re Application of: Mark L. Boyer et al.

Application No. 09/239878	Filing Date January 29, 1999	Examiner Lanna Mai	Group Art Unit 3637
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Invention: PRE-CAST SECURITY VAULT

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed: March 10, 2004.

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Daniel G. Nguyen
Attorney Reg. No. : 42,933
JENKENS & GILCHRIST, A PROFESSIONAL
CORPORATION
5 Houston Center
1401 McKinney, Suite 2700
Houston, Texas 77010
(713) 951-3354

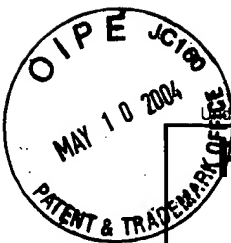
Dated: May 10, 2004

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Dated: May 10, 2004

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(Jimmy Patterson)

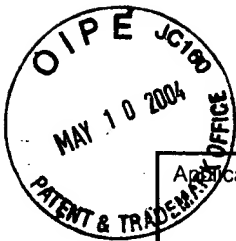


FEE TRANSMITTAL for FY 2004 <small>Effective 10/01/2003, Patent fees are subject to annual revision.</small>		Complete if Known	
		Application Number	09/239878
		Filing Date	January 29, 1999
		First Named Inventor	Mark L. Boyer
		Examiner Name	Lanna Mai
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27	Art Unit	3637	
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SUBMITTED BY		(Complete if applicable)	
Name (Print/Type)	Daniel G. Nguyen	Registration No. (Attorney/Agent)	42,933
Signature		Telephone	(713) 951-3354
		Date	May 10, 2004

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Application No. (if known): 09/239878

Attorney Docket No.: 41241-00006USD1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Mark L. Boyer et al.	§	Art Unit:	3637
Serial No.:	09/239,878	§	Examiner:	Lanna Mai
Filing Date:	January 29, 1999	§		
Title:	PRE-CAST SECURITY VAULT	§		

MS Appeal Brief
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Type or Print Name:	<u>JIMMY PATTERSON</u>
Signature:	<u><i>[Signature]</i></u>

APPELLANT'S BRIEF UNDER 37 C.F.R. § 1.192

Appellant takes this appeal from the October 31, 2003, final Office Action in the above-identified application. On March 10, 2004, Appellant filed a Notice of Appeal. Appellant hereby files this Appellant's Brief in triplicate in connection with the Notice of Appeal.

1. REAL PARTIES- IN-INTEREST

The real parties in interest are Mark L. Boyer and Michael E. Barker who are the named inventors in this application.

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2. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant or Appellant's attorneys that will directly affect, or be directly affected by, or have a bearing on, the Board's decision in the pending Appeal.

3. STATUS OF CLAIMS

Claims 33-34 and 36-37 are pending in this application and are the claims from which this Appeal is taken. These claims were finally rejected in an Office Action dated October 31, 2003. Claims 1-16 were canceled prior to examination on the merits. Claims 17-22 were canceled in a Reply filed on November 4, 1999. Claims 23-26 were canceled in a Reply filed on May 25, 2000. Claims 27-29 were canceled in a Preliminary Amendment filed on April 23, 2001, with the Continuing Prosecution Application (CPA) that resulted in this application. Claims 30-32 were withdrawn by the Examiner in an Office Action dated June 14, 2000, as being directed to a non-elected invention. Claims 35 and 38 were canceled in a Reply filed June 11, 2003. Claim 39 was withdraw from further consideration in a Reply filed December 31, 2003.

A copy of the currently pending claims is attached in Appendix A.

4. STATUS OF AMENDMENTS

All amendments have been entered.

5. SUMMARY OF INVENTION

Appellant's claims are directed to a modular vault. Appellant notes that the United States Patent and Trademark Office has issued other patents related to vaults, including U.S. Patent No. 6,003,271 (Boyer et al.) entitled "Pre-cast Security Vault."

Appellant's modular vault, as claimed in independent Claim 33, comprises a seamless housing body that is unitarily formed as a single piece. The seamless housing body has portions that define a front wall, a rear wall, two side walls, a roof, and a floor. The front wall has a door opening. A doorframe of the modular vault is positionable in the door opening, and a door of the modular vault is mountable in the doorframe. The door is preferably fire resistant and burglary proof. See, e.g., page 7, lines 5-17; Figure 4.

An advantage of the claimed invention is the housing body is unitarily formed as a single piece. As such, the modular vault can be entirely prefabricated at a remote facility, then transported to a desired location for installation. To install, the modular vault can be conveniently dropped into place without any additional assembly. Thus, the expenses and difficulties associated with constructing a vault in-place are avoided. Another advantage is that the housing body is seamless. The seamless housing body renders the modular vault vapor-tight and, therefore, better able to protect the contents of the vault from external environmental influences. See, e.g., page 7, lines 11-31; Figures 5-6.

Independent Claim 36 recites substantially the same limitations as Claim 33, but further clarifies that the modular vault is a walk-in vault.

Defendant Claims 34 and 37 further define the modular vault in that hooks may be integrally formed in the housing body to facilitate hoisting thereof.

Appellant's main claims are reproduced below with reference numerals inserted for easy reference to the Specification:

33. A modular vault comprising:
a seamless housing body (100) unitarily formed as a single piece, said seamless housing body (100) having portions defining a front wall (20) having a door opening therethrough, a rear wall (104), two side walls (106, 108), a roof (110) and a floor (112);
a door frame (116) positionable in the door opening; and
a door (118) mountable in the door frame (116) whereby said vault is fire resistant and burglary proof.
36. A modular walk-in vault comprising:
a seamless housing body (100) unitarily formed as a single piece, said seamless housing body (100) having portions defining a front wall (20) having a door opening therethrough, a rear wall (104), two side walls (106, 108), a roof (110) and a floor (112);
a door frame (116) positionable in the door opening; and
a door (118) mountable in the door frame (116) whereby said vault is fire resistant and burglary proof.

6. ISSUES

- I. Whether U.S. Patent No. 1,412,784 ("Holmberg") teaches every element of the claimed invention under 35 U.S.C. § 102(b).
- II. Whether U.S. Patent No. 5,493,817 ("Speer") is analogous art under 35 U.S.C. § 103(a).
- III. Whether there is motivation to combine Holmberg and Speer under 35 U.S.C. § 103(a).
- IV. Whether the combination of Holmberg and Speer under 35 U.S.C. § 103(a) produces the claimed invention.

7. GROUPING OF THE CLAIMS

Claims 33 and 36 are the only independent claims pending in the application. Claims 34 and 37 each recite independently allowable subject matter in addition to being dependent on

Claims 33 and 36, respectively. Accordingly, the claims do not stand or fall together for purposes of this Appeal.

8. ARGUMENTS IN SUPPORT OF THE CLAIMS

I. Holmberg Fails to Teach Every Element of the Claimed Invention

In the Final Office Action dated October 31, 2003, the Examiner rejected all Claims 33-34 and 36-37 as being anticipated by Holmberg under 35 U.S.C. § 102(b). Applicant respectfully submits that Holmberg does not anticipate the invention as recited in the claims because it fails to teach each and every element of the claims.

A. Anticipation

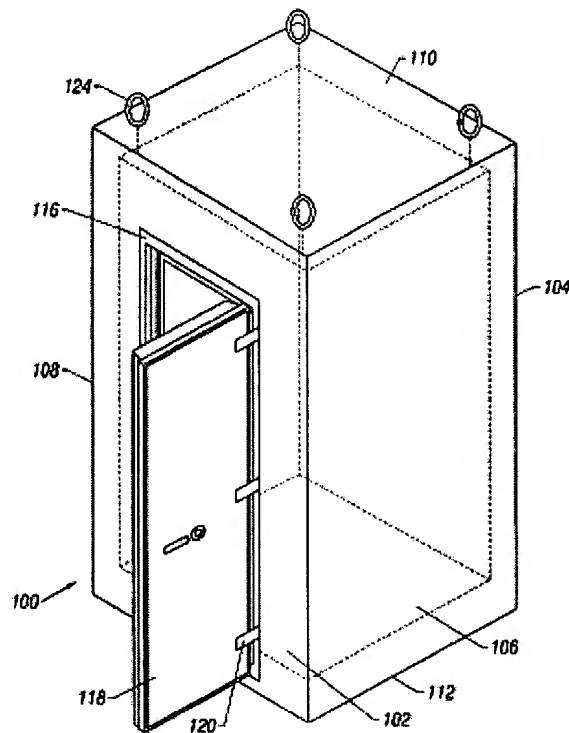
To anticipate a claim, a prior art reference must teach each and every element of the claim. See, e.g., *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) (“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Id.* at 631. Stated another way, there must be no difference between the claimed invention and the prior art reference as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

B. The Claimed Invention

Appellant’s modular vault, as claimed in independent Claim 33, comprises a **seamless** housing body that is unitarily formed as a single piece. An example of the modular vault is illustrated in Figure 4 of the application, reproduced below. The seamless housing body has

portions that define a **front wall**, a rear wall, two side walls, a roof, and a floor. The front wall has a door opening therethrough. A **door frame** of the modular vault is positionable in the door opening, and a door is mountable in the doorframe.

Independent Claim 36 recites substantially the same limitations as Claim 33, but clarifies that the modular vault is a walk-in vault.

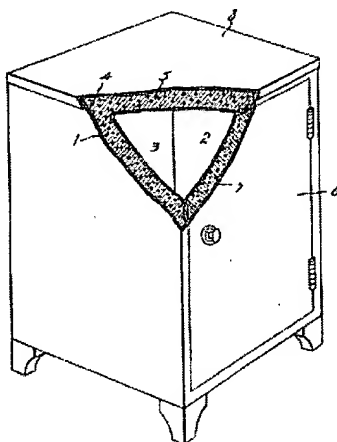


Application, Figure 4

C. The Holmberg Reference

The Holmberg reference is directed to fireproof furniture such as safes, filing cabinets, strong boxes, and similar articles. Figure 1 of the Holmberg reference is reproduced below for convenient reference. As can be seen, Holmberg is **not** directed to a vault. The specification and drawings of Holmberg show only a safe. The Holmberg safe has an outer metal casing that

surrounds, and is spaced apart from, two inner side walls, a rear wall, and the bottom of the safe. The intervening space between the interior walls and the outer casing is then filled with a fireproof material to make the safe fireproof. Holmberg, p. 1, ll. 28-45.



Holmberg, Figure 1

D. Holmberg Fails to Teach a Seamless Housing Body

To anticipate, Holmberg must teach each and every element recited in the claims. Applicant respectfully submits that Holmberg fails to anticipate the claimed invention because it does not teach the **seamless** housing body. Indeed, Holmberg does not even disclose or suggest a **unitary** housing body, much less one that is seamless. Holmberg merely states that the outer casing of the safe is devoid of all joints (Holmberg, p. 1, ll. 75-81), not that the **entire safe** is devoid of all joints or seamless. The Examiner appears to have inferred from this statement, however, that the entire Holmberg safe is devoid of all joints.

On the contrary, Holmberg actually teaches the presence of at least one joint or seal on the fireproof safe. Holmberg explains that the fireproof safe is formed by pouring a liquid mass of fireproof material between the inner walls of the safe and the outer metal casing, with a

sufficient quantity of liquid mass to also cover the top of the safe. Holmberg, p. 1, ll. 54-60. The fireproof material is allowed to dry and a cover plate is then fastened on top of the safe. The fastening of the cover plate on top of the safe necessarily creates a seam where the edge of the cover plate extends over the outer metal casing. See Holmberg, Figure 1. Therefore, Applicant respectfully submits the Holmberg safe is not seamless.

Possibly the Examiner only considers the Holmberg fireproof material alone as forming the requisite seamless structure, disregarding the outer metal casing and inner walls. Even under this strained interpretation, however, Holmberg fails to teach the claimed **seamless** housing body. This is because Holmberg only discloses pouring the liquid mass of fireproof material between the outer metal casing and the inner walls of the safe. Nowhere does Holmberg disclose or suggest pouring the liquid mass between the outer metal casing and the **bottom** of the safe. Holmberg, p. 1, ll. 54-60. Thus, the fireproof material in the inner walls of the safe does not include or is not an extension of the bottom of the safe. As a result, there will necessarily be a seal at the point where the bottom of the safe and the fireproof material meet.

E. Holmberg Fails to Teach a Front Wall

Holmberg also fails to anticipate the claimed invention on the basis that it does not teach the claimed **front wall**. The Holmberg safe instead has a front door that takes up the entire front side of the safe, leaving no room for a front wall. Nevertheless, the Examiner insists that the edges of the side walls, top cover, and bottom surrounding the door satisfy the structural requirements of a wall. October 31, 2003, Office Action, p. 4. No person of ordinary skill in the art, however, would consider such a contrived definition to be a wall.

Furthermore, absent an express intent to impart a novel meaning, terms in a claim are to be given their ordinary and accustomed meaning. *Hockerson-Halberstadt, Inc. v. Avia Group International, Inc.*, 222 F.3d 951, 955, 55, USPQ2d 1487, 1490 (Fed. Cir. 2000). In the present case, Applicant has imparted no special meaning to the claimed “front wall”. Therefore, the Examiner must give this term its ordinary and accustomed meaning. The ordinary and accustomed meaning of the term “wall” is a protective or restrictive barrier. See *The Concise Oxford Dictionary*, 10th Edition. As near as Applicant can tell, there is nothing protective or restrictive about the edges surrounding the door. Only the door itself provides any measure of protection or restriction for the safe, not the edges surrounding the door.

F. Holmberg Fails to Teach a Door Frame

Even assuming that the Holmberg safe has a “front wall,” Holmberg fails to teach a **door frame** positionable in a door opening of the front wall. Holmberg merely shows a door opening in the safe. It does not show both a door frame and a door opening (i.e., two separate elements) as recited in the independent claims. The door of the Holmberg safe is not mounted on a door frame at all, but is instead attached directly to one of the side walls. Perhaps the top, bottom, and side walls that define the door opening may be considered to “frame” the door, but that is a far cry from having both a door frame and a door opening (again, two separate elements).

G. Holmberg Fails to Teach a Walk-in Vault

With respect to claim 36, Holmberg further fails to teach the claimed **walk-in vault**. Indeed, the Holmberg safe is not even a vault. Holmberg use terms such as “furniture,” “filing cabinets,” “boxes,” and other “similar articles” to describe the safe. It does not use the term “vault.” The Examiner contends, nevertheless, that the Holmberg safe is not only a vault, but is

also a walk-in vault. The Examiner bases this latter point on the assumption that any child, dog, or other small pet could walk into the safe. October 31, 2003, Office Action, p. 4.

Most children, dogs, and other small pets, however, would not have need for and could not normally buy a vault. Therefore, the term “walk-in vault” is customarily understood by those who labor in this art to mean a room or chamber that is large enough for an average size adult to walk into. (See also, e.g., walk-in closet, walk-in freezer, etc.) This is illustrated, for example, by the size of the walk-in vault door in the advertisement attached in Appendix B, which shows that a typical walk-in vault door is some 80 inches high and 30 inches wide. As such, the Holmberg safe is not a walk-in vault.

Accordingly, based on the foregoing, Applicant respectfully submits that Holmberg does not anticipate the claimed invention.

II. Speer Is Not Analogous Art to the Claimed Invention

In the Final Office Action dated October 9, 2001, the Examiner rejected all Claims 33-35 under 35 U.S.C. § 103 as being unpatentable over the combination of Holmberg and Speer. Appellant respectfully submits that Speer is not analogous art for purposes of 35 U.S.C. § 103(a).

A. Analogous Art

Whether a reference may be treated as analogous art is determined by a two-step process. First, it must be determined whether the reference is “within the field of the inventor’s endeavor.” Second, if the reference is outside that field, it must be determined whether the reference is “reasonably pertinent to the particular problem with which the inventor was involved.” *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

A reference is reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference has the same purpose as the claimed invention, then the reference relates to the same problem, and that fact would support the use of the reference in an obviousness rejection. *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

B. The Speer Reference

The Speer reference is directed to a mobile workshop system for manufacturing, maintaining, inspecting, servicing, and testing downhole equipment. Speer, Abstract. The mobile workshop comprises a structure that has four walls, a top, and a floor portion, and is capable of being transported as a closed container. *Id.* Speer specifically states that the mobile workshop is intended for use at oil rig sites. Speer, col. 1, ll. 8-13.

C. Speer Is Not in the Same Field of Endeavor as the Claimed Invention

The first step in the two-step process outlined by *In re Deminski* is to determine whether the prior art is in the same field of endeavor as the claimed invention. Clearly, Speer is not in the same field of Endeavor as the claimed invention. The field of endeavor of the claimed invention is walk-in vaults. See, e.g., page 1, lines 5-8. Note that the term "vault" is recited in the body of the claims as well as in the preamble and throughout the specification. In contrast, nowhere does the term "vault" appear in Speer. Instead, the Speer field of endeavor is mobile workshops for use at oil rig sites. Speer, col. 1, ll. 8-13.

D. Speer Is Not Reasonably Pertinent to the Claimed Invention

The second step in the two-step process outlined by *In re Deminski* is to determine whether the prior art is reasonably pertinent to the claimed invention. To be reasonably pertinent, the prior art and the claimed invention must share the same purpose. The purpose of the claimed invention is to provide a walk-in vault that can be easily and quickly installed inside a building. The inventors recognized that, while walk-in vaults are very desirable for their high level of security, existing walk-in vaults had to be built in-place. Being built in-place, however, made walk-in vaults too expensive for the average person and prolonged building construction time. It also made it more difficult to add a walk-in vault to an existing building. To solve this problem, the inventors created a walk-in vault that is entirely prefabricated. Such a prefabricated walk-in vault could then be quickly and easily installed inside a building. See, e.g., page 1, lines 5-22; page 7, lines 11-31; Figures 5-6.

The purpose of Speer, on the other hand, is to provide sufficient equipment space and storage space in a standard transportation container. Speer recognized that there is a constant need to maintain, repair, and refurbish downhole drilling, completion, or production equipment. To solve this problem, Speer created an improved mobile workshop that reconfigurable on-site by retracting the walls of the workshop from a vertical position to a horizontal position. This allows the mobile workshop to be modified as needed to accommodate different type and size equipment. Speer, col. 2, ll. 3-24. Therefore, the purpose of Speer is not reasonably pertinent to the claimed invention.

Accordingly, based on the foregoing, Applicant respectfully submits that Speer is not analogous art to claimed invention.

III. There Is No Motivation to Combine Holmberg and Speer.

Even assuming that Speer is analogous art to the claimed invention, Applicant respectfully submits there is no motivation to combine Holmberg and Speer under 35 U.S.C. § 103(a).

A. Motivation to Combine

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” *In re Sang Su Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1443 (Fed. Cir. 2002). “There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The mere fact that a device in a cited reference could have been modified to yield a device within the claimed invention does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The Examiner can satisfy the burden of showing obviousness of the modification **“only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.”** *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (emphasis added).

B. There is No Objective Teaching That Would Motivate the Combination

In the present case, the Examiner urged that it would have been obvious for one skilled in the art to modify the Holmberg safe with hooks as taught by Speer in order to be able to hoist the safe. Applicants respectfully disagree. First of all, there is no problem whatsoever that can be gleaned from the text of Holmberg or from the knowledge of those skilled in the art that would motivate the skilled artisan to modify the Holmberg safe with integrated hooks. Holmberg is

directed to a fireproof safe. Adding integrated hooks to the safe does not address in any way the problem of making the safe fireproof.

C. Holmberg and Speer Are in Unrelated Fields of Endeavor

Secondly, Holmberg and Speer are in completely unrelated fields of endeavors. Whereas Holmberg is directed to making a safe fireproof, Speer is directed to providing mobile workshops for the oilfield services industry. Specifically, Speer is directed to a mobile workshop system for manufacturing, maintaining, inspecting, servicing, or testing downhole equipment. Thus, even if a person having ordinary skill in the safe making art detected some drawback in the Holmberg safe that needed to be addressed, he would not look in the Speer oil field services art for a solution.

IV. The Combination of Holmberg and Speer Does Not Produce the Claimed Invention

Even assuming further that there is motivation to combine Holmberg and Speer, Appellant respectfully submits that the combination would fail to produce the claimed invention. As explained above, the modular vault of the claimed invention includes a **seamless** housing body that is unitarily formed as a single piece. Nowhere does Holmberg disclose or suggest a housing body that is seamless and unitarily formed as a single piece. Further, nowhere does Holmberg disclose or suggest that the housing body has a **front wall** or a **door frame** positionable in a door opening of the front wall.

Likewise, Speer also fails to disclose or suggest a **seamless** housing body unitarily formed as a single piece, a **front wall** in the housing body, or a **door frame** positionable in a door opening of the front wall. Speer fails to even disclose a vault, much less one that is seamless and has a front wall and a door frame.

Accordingly, Appellant respectfully submits that the combination of Holmberg and Speer would fail to produce the claimed invention.

9. CONCLUSION

For all of the foregoing reasons, Appellant requests that the Board of Patent Appeals and Interferences reverse the decision of the Examiner in whole and explicitly state that Claims 33-34 and 36-37 are allowable.

A check for \$165.00 is enclosed for the filing of this Appellant's Brief but, the Commissioner is hereby authorized to charge any additional fee which may be required, or credit any overpayment, to Deposit Account No. 10-0447, Reference No. 41241-6USD1 (DGN).

Respectfully submitted,

Date: 5/10/04



Daniel G. Nguyen (Reg. No. 42,933)
JENKENS & GILCHRIST, P.C.
1401 McKinney, Suite 2700
Houston, Texas 77010
Telephone No.: (713) 951-3354
Telecopy No.: (713) 951-3314



APPENDIX A

33. A modular vault comprising:
- a seamless housing body unitarily formed as a single piece, said seamless housing body having portions defining a front wall having a door opening therethrough, a rear wall, two side walls, a roof and a floor;
 - a door frame positionable in the door opening; and
 - a door mountable in the door frame whereby said vault is fire resistant and burglary proof.
34. A modular vault of claim 33, wherein a plurality of hooks are integrally formed into the seamless housing body for facilitating hoisting the seamless housing body.
36. A modular walk-in vault comprising:
- a seamless housing body unitarily formed as a single piece, said seamless housing body having portions defining a front wall having a door opening therethrough, a rear wall, two side walls, a roof and a floor;
 - a door frame positionable in the door opening; and
 - a door mountable in the door frame whereby said vault is fire resistant and burglary proof.
37. A modular walk-in vault of claim 36, wherein a plurality of hooks are integrally formed into the seamless housing body for facilitating hoisting the seamless housing body.



APPENDIX B



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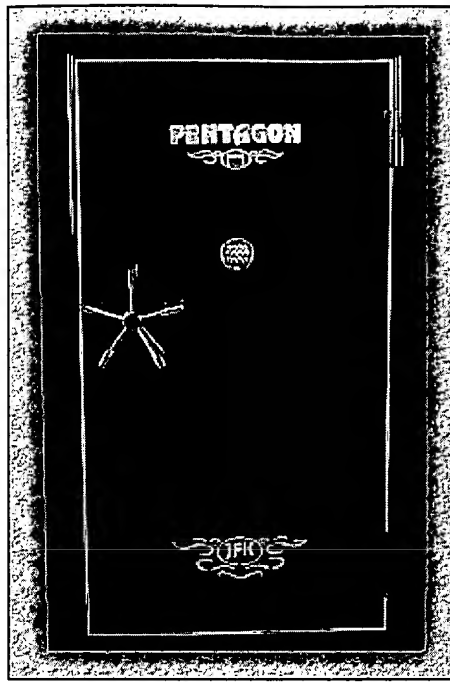
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